



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:)
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Watts, Jr. et al.) Examiner: Simone, Catherine A.
)
Serial No.: 10/783,076) Art Unit of Appln: 1772
)
Filed: February 20, 2004) Confirmation No.: 6275
)
For: SURFACE COVERING HAVING) Customer No.: 00112
DIFFERENTIAL GLOSS-IN-)
REGISTER) Docket No.: 0122A

AMENDED APPEAL BRIEF

Submitted in Response to Notification of Non-Compliant Appeal Brief

Mailed June 14, 2007

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

This brief is submitted pursuant to 37 CFR 1.192 in support of the Notice of Appeal filed December 26, 2006, in the above-identified application and in response to the Notification of Non-Complaint Appeal Brief (37 CFR 41.37), mailed June 14, 2007. The Patent Appeal Center Specialist objected to the form of the previous Appeal Brief, which was filed April 30, 2007, for not identifying the appealed claims, in compliance with 37 CFR 41.37 (c)(1)(vii) and not mapping the claimed invention to identify the independent claims. This New Appeal Brief corrects these errors in form.

A request for a one-month extension of time to August 14, 2007, and payment of the fee charged to Deposit Account No. 012400 is included in the transmittal letter, filed herewith.

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REAL PARTY IN INTEREST

The real party in interest in this application is Armstrong World Industries, Inc., the assignee of the present application.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, or Appellants' legal representatives, which will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending Appeal.

STATUS OF CLAIMS

Claims 34 to 49 are pending in the application. Claims 34 to 49 are rejected. Claims 1 to 33 have been canceled. The rejection of all of the pending claims is appealed.

STATUS OF AMENDMENTS

The Amendment and Response, filed on June 12, 2006, was entered. Therefore, the claims are as they appear in the June 12, 2006, response.

SUMMARY OF CLAIMED SUBJECT MATTER

The invention is a coated freestanding film, which includes a film having a print layer forming a pattern or design disposed on one side of the film and a discontinuous gloss layer disposed on the other side of the film substantially in-register with at least a portion of the printed pattern or design. The gloss layer has at least one portion thereof which has a gloss level different from the gloss level of the side of the film upon which the gloss layer is disposed.

Element-by-element support for the independent claims and dependent claims argued separately is found in the original application as set forth below:

Claim 34:

Coated freestanding film - paragraphs 2, 24, 26, 29, 30, 31, 53, 57 to 60, 64, 65, 71 to 73 and 79, for example.

Opposed first and second sides – paragraphs 8, 12, 15, 24 to 26, 28 to 30, 32, 33, 39, 53, 73, 74, 80 to 82 and 84, for example.

Print layer having a printed pattern or design, the print layer being disposed on the first side of the film – paragraphs 8, 12, 15, 25, 29, 30, 32, 53, 80 and 82, for example.

Discontinuous layer forming a pattern or design disposed on the second side of the film having a gloss level different from the gloss level of the second side of the film – paragraphs 8, 12, 29, 30, 53 and 80, for example.

Claim 41:

The film comprises a plurality of film layers – paragraph 35, for example.

Claim 49:

Coated freestanding film - paragraphs 2, 24, 26, 29, 30, 31, 53, 57 to 60, 64, 65, 71 to 73 and 79, for example.

Opposed first and second sides – paragraphs 8, 12, 15, 24 to 26, 28 to 30, 32, 33, 39, 53, 73, 74, 80 to 82 and 84, for example.

Discontinuous layer forming a pattern or design disposed on the second side of the film having a gloss level different from the gloss level of the first side of the film – paragraphs 8, 12, 29, 30, 53 and 80, for example.

Mechanically embossed surface texture – paragraph 54, for example.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 34, 38, 39, 41 to 43, 47 and 48 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bomboire U.S. Patent No. 4,089,724 (Bomboire).

Claims 45, 46 and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bomboire in view of Schmidle et al. U.S. Patent No. 4,273,819 (Schmidle).

ARGUMENT

In the Final Office Action mailed from the U. S. Patent and Trademark Office (PTO) on August 23, 2006, the Primary Examiner maintained the rejection of all of the pending claims.

Attorney for Applicants will argue separately the patentability of claims 34, 41 and 49. Claims 35 to 40 and 42 to 48 stand or fall with claim 34 from which they directly or indirectly depend.

Section 102(b) Rejection of Claims 34, 38, 39, 41 to 43, 47 and 48 over Bomboire

Claim 34

In the middle of page 2 of the Final Office Action mailed August 23, 2006, (“the Final Office Action”), the Examiner maintained her rejection of claim 34, citing various passages of Bomboire which disclose the elements of claim 34 and stating “It is pointed out that the phrase ‘consisting essentially of’ is being construed as equivalent to ‘comprising’.”

Attorney for Applicants had argued that claim 34 had been amended to require the coated freestanding film to consist essentially of a freestanding film, a print layer and a discontinuous layer on the opposite side of the freestanding film from the print layer and that the film of Bomboire required a support or base sheet 1, which is not interposed between the print layer and the discontinuous layer, citing column 2, lines 10 to 13; column 3, lines 65 and 66; column 5, lines 5 to 10 and 35 to 38; and Figure 2, of Bomboire.

The freestanding film 41 of Bomboire does not include a print layer and a discontinuous layer on the opposite side of the freestanding film for the print layer. As shown in Figure 2 of Bomboire, the freestanding film (wear layer or transparent sheet) 41 is applied to the support 1 after the printed decoration 31 is applied to the support 1. Then the discontinuous plastisol 33 is applied to the film 41. Therefore, Bomboire does not teach or suggest a freestanding film having

a print layer and a discontinuous layer, as required by claim 34, but a freestanding film without a print layer and a discontinuous layer which is applied to a printed substrate and then having a discontinuous layer applied.

The term “freestanding” in the preamble does have significance and distinguishes the claimed invention from Bomboire. The film of Bomboire when it is interposed between a print layer and a discontinuous layer is not freestanding. It is laid on and adhered to the support 1.

Further, whether claim 34 was properly rejected depends upon whether it is proper to construe the phrase “consisting essentially of” as equivalent to “comprising”. In the first full paragraph on page 7 of the Final Office Action, the Examiner states:

“that the transitional phrase ‘consisting essentially of’ limits the scope of a claim to the specified materials or steps ‘and those that do not materially affect the basic and novel characteristic(s)’ of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). According to the MPEP, section 2111.03, for the purpose of applying prior art under 35 U.S.C. 102 and 103, ‘absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising”.’ In the present application, there appears to be no clear indication in the specification and claims of what the basic and novel characteristics actually are. Furthermore, Applicant has [sic, Applicants have] not clearly stated that which would materially affect the basic and novel characteristics of the claimed invention. Therefore, the phrase ‘consisting essentially of’ in claims 34 and 49 will be construed as equivalent to ‘comprising’. Thus, Bomboire clearly teaches the coated freestanding film as presently claimed.”

(Emphasis in original.)

The basic and novel characteristics of the claimed invention is set forth in paragraph 7 of the specification, i.e. to meet the “need for a surface covering which has a differential gloss effect printed onto a film which is in-register with a printed or a mechanically embossed pattern or design thereon.” The claimed freestanding film meets the needs of the prior art set forth in paragraph 4 of the specification of avoiding the “multiple coat cure stations consisting of a coater

and ultraviolet (UV) medium pressure-mercury vapor lamps” required by the “filmless product” of the prior art and the associated “[c]apital investment requirements in radiation cure equipment utilized to apply such coatings onto a decorative substrate [which] can be significant.”

As stated in paragraph 14 of the specification, the coated freestanding film of the present invention “successfully addresses the shortcomings of and provides distinct advantages over existing surface coverings and their method of manufacture”, such as the surface covering disclosed in Bomboire. There is no teaching or suggestion of a coated freestanding film in Bomboire. Rather, Bomboire discloses a method in which the design pattern, wearlayer and differential gloss are formed on the surface covering substrate, instead of forming a freestanding film with the design pattern and differential gloss, and then laminating the film to the substrate, as presently claimed.

Therefore, the support or base 1 of Bomboire materially changes the aforementioned basic or novel characteristics of the Applicants’ invention. The structure taught in Bomboire is a surface covering, particularly a floor or wall covering, and not a freestanding film, which is subsequently laminated to a surface covering substrate to form the surface covering. The floor manufacturer using the Bomboire method must invest in the plurality of printing cylinders 5a, 7a, 9a and 11a and the plastisol dispensing device 13, which a floor manufacturer using the presently claimed freestanding film would avoid. Therefore, claim 34 and the claims dependent thereon are not anticipated by Bomboire and should be allowed.

Claim 41

With regard to claim 41, near the bottom of page 2 of the Final Office Action, the Examiner repeated her rejection of claim 41 stating “the film [of Bomboire] comprises a plurality of film layers (see col. 5, line 46).” Attorney for Applicants argued in the previous Amendment

and Response, filed June 12, 2006, that the film Bomboire discusses at column 5, lines 44 to 46, is the support 1 and not the transparent sheet 41. Bomboire does not teach or suggest the transparent sheet 41, which is interposed between the printed decoration 31 and the discontinuously applied plastisol 33, comprise a plurality of layers.

At the bottom of page 7 of the Final Office Action, the Examiner responded stating that “in column 4, lines 46-66, Bomboire teaches the film including a plurality of film layers. Therefore, Bomboire clearly teaches the film having a plurality of film layers as recited in claim 41.”

However, the now cited passage of Bomboire states “Subsequent to deposition of the wear layer 41, the multi-layer composite is passed through a gelation oven 39.” The “multi-layer composite” which passes through the gelation oven is the wear layer 41, the plastisol paste layer 33, the printed decoration layer 31 and support or base sheet 1, and not a multi-layered wear layer. See Figure 1 and column 4, lines 27 to 37. Therefore, claim 41 is allowable over Bomboire for this reason as well.

Section 103(a) Rejection of Claim 49 over Bomboire in view of Schmidle

In response to the Office Action mailed March 8, 2006, Attorney for Applicants amended claim 49 in a manner similar to the amendment of claim 34, changing “comprising” to “consisting essentially of”. At the top of page 5 of the Final Office Action, the Examiner maintained her rejection of claim 49 as set forth in the Office Action mailed March 8, 2006, adding with regard to claim 49 the statement “It is pointed out that the phrase ‘consisting essentially of’ is being construed as equivalent to ‘comprising’”. Therefore, the arguments set

forth above with respect to claim 34 apply with equal force to the rejection of claim 49 and claim 49 is allowable over Bomboire in view of Schmidle.

Respectfully submitted,

8/13/07
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CLAIMS APPENDIX

Pending Claims

34. A coated freestanding film consisting essentially of
- a freestanding film having opposed first and second sides;
- a print layer having a printed pattern or design, the print layer being disposed on the first side of the film; and
- a discontinuous layer forming a pattern or design disposed on the second side of the film having a gloss level different from the gloss level of the second side of the film.
35. The coated freestanding film according to claim 34, wherein the discontinuous layer has a thickness between about 0.1 mils and less than about 0.5 mils.
36. The coated freestanding film according to claim 35, wherein the discontinuous layer has a thickness between about 0.1 mils and about 0.45 mils.
37. The coated freestanding film according to claim 36, wherein the discontinuous layer has a thickness between about 0.1 mils and about 0.4 mils.
38. The coated freestanding film according to claim 34, wherein the print layer is at least partially viewable through the film.

39. The coated freestanding film according to claim 34, wherein the discontinuous layer comprises first and second portions, the first portion having a gloss level different from the gloss level of the second portion.

40. The coated freestanding film according to claim 34, wherein the print layer comprises a chemical embossing agent.

41. The coated freestanding film according to claim 34, wherein the film comprises a plurality of film layers.

42. The coated freestanding film according to claim 34, wherein the discontinuous layer has a portion in-register with a portion of the printed pattern or design.

43. The coated freestanding film according to claim 34, wherein the film is a rigid or semirigid film.

44. The coated freestanding film according to claim 34, wherein the film is a vinyl film having less than 5 parts plasticizer per hundred parts by weight of the vinyl resin.

45. The coated freestanding film according to claim 34, wherein the film has a mechanically embossed surface texture.

46. The coated freestanding film according to claim 45, wherein the mechanically embossed surface texture of the film is in-register with the pattern or design of the discontinuous layer.

47. The coated freestanding film according to claim 46, wherein the discontinuous layer comprises first and second portions, the first portion having a gloss level different from the gloss level of the second portion.

48. The coated freestanding film according to claim 34, wherein the discontinuous layer comprises a flatting agent, a texturing agent and combinations thereof.

49. A coated freestanding film consisting essentially of
a freestanding film having opposed first and second sides;
a discontinuous layer forming a pattern or design disposed on the second side of the film having a gloss level different from the gloss level of the first side of the film; and
the film having a mechanically embossed surface texture.

EVIDENCE APPENDIX

None

Appl. No. 10/783,076
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RELATED PROCEEDINGS APPENDIX

None